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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,359	11/19/2001	Scott D. Slomiany	2100/23	1396

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,359

Applicant(s)

SLOMIANY ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 109-115 is/are rejected. 109-115 *JK*
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 109-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US Patent Number 5,263,715) in view of Edgeworth (US Patent Number 2,125,236) and Bunco Rules.

Claim 109: Matsumoto teaches a gaming machine with a video display device (1) and a CPU (17) having a program operating a dice game. (Abstract). There is a wager input mechanism (6) which registers a wager placed by a player. The program establishes a set of differing game play dice elements (e., there are two dice). Matsumoto teaches craps. (Col 2, 61-63) In craps, there is a subset of at least one match point at the start of the game. If a player throws a 7 or 11 (a natural), the player wins. If the player throws a 2, 3, or 12 (a crap), the player loses. If the player throws any other number, the player must continue to throw until the player matches the number originally thrown (the point) or throws a 7. These naturals, craps, and points are all match points. Each match point has a match indicium (i.e., pips on the dice) for potential matching with a subsequent toss of the dice elements. The program establishes and displays a random toss of a plurality of dice elements at each stage of play, and determines at a stage of play whether the randomly selected indicium matches the match indicium of the match point. There is a

payout mechanism providing an award according to a predetermined payable for each match on a toss. (Col 3, 14-18) (Figs 4 & 5)

Matsumoto does not, however, teach Bunco or matching each die element tossed with the indicium on a single die. Edgeworth teaches implementing Bunco on a slot machine. (Col 1, 32-36) In Bunco, each die element tossed is matched with the indicium on a single die. Bunco is an extremely popular game and has been for over a century. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto in view of Edgeworth (and the rules of Bunco) to have implemented a Bunco game in which each die element tossed is matched with the indicium on a single die in order to take advantage of the popularity of Bunco.

Claim 110: The rules of Bunco describe a bonus (i.e., fuzzy dice) for scoring a "Bunco". A Bunco is when all dice match the match point. Furthermore, progressive jackpots (i.e., those that increase with each round of play until won) are well known to the art. Such bonus awards attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto in view of Edgeworth and the rules of Bunco to have the payout mechanism include a second payable provided for a bonus award, said second payable increasing in bonus award value with each successive stage of play (a progressive jackpot), and including the step of awarding a bonus award if all dice elements on a toss have the same randomly selected indicium which also matches a match indicium in order to implement the suggestion of an award for scoring a Bunco and to attract players.

Claim 111: Bunco uses three dice (i.e., three dice elements are established and displayed as being tossed at each stage of play.)

Claim 112: In Bunco, any match point that is not matched on a toss is eliminated. (If the match point is 2 and the player fails to throw a 2, the “2” round is over and that match point is eliminated.) The rules teach determining whether to continue with a toss on a subsequent stage of play up to a preset maximum number of stages (6) provided that at least one match point remains for each such subsequent stage. If a player tosses a 1 in the 1 round, the 1 round continues until the player tosses a set of dice that does not contain a 1. Then the player tries to match the next match point (2). This continues through six rounds.

Claim 115: Edgeworth teaches a game of “twenty six” in which a plurality of match points are established, each of said plurality of match points having a match indicium selected at random (by the player). Some or all of the match indicia of the plurality of match points may thereby be the same. (Col 1, 13-31) (Note that when playing by hand, the player is described as choosing a single match point. But the machine version allows the choosing of multiple match points –“through the intermediation of a token for each point chosen.” (Col 1, 26-27)

3. Claims 113 & 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto, Edgeworth and Bunco Rules as applied to claim 109 above, and further in view of Falciglia (US Patent Number 5,647,798).

Claims 113 & 114: Matsumoto, Edgeworth and Bunco Rules teach the invention substantially as claimed, but do not teach randomly allocated free advancement features

(i.e., "free spins") or their use to continue the game when it would otherwise terminate.

Falciglia teaches "free spins". Free spins are well known to attract players because they give a player a second chance when the player would otherwise lose. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Matsumoto, Edgeworth and Bunco Rules in view of Falciglia to randomly allocate free advancement features (i.e., "free spins") to be used to continue the game when it would otherwise terminate in order to give a player a second chance when the player would otherwise lose, thus attracting players.

Response to Arguments

4. Applicant's arguments filed 28 June 2004 have been fully considered but they are not persuasive.
5. Applicant argues that the references do not teach a video display device. Matsumoto clearly includes a video display device (1).
6. Applicant argues that the references do not teach a program to match the preset or randomly selected match point to the randomly selected indicia of a dice element, which also determines the payout. Applicant is referred to the rejection of claim 109 above, where this limitation is clearly addressed.
7. Applicant argues that the combination of references would include elements (trackballs, etc.) not described in Applicant's specification or claimed in Applicant's claims. Applicant's claims use the word "comprising". Applicant is no doubt aware that "comprising" is an open-ended term. If Applicant wishes to exclude additional elements, Applicant should narrow the claims by use of the term "consisting of".

8. Applicant argues that the invention is unobvious because there are no other video gaming machines based on Bunco on the market. Unfortunately for the Applicant, this is NOT the standard of patentability. Patentability is determined by looking at the teachings of the art as a whole. As pointed out above, the art, when considered as a whole, teaches Applicant's claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

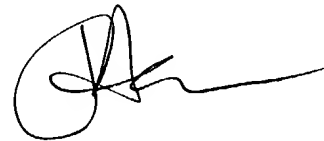
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (703) 308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cbc



JESSICA HARRISON
PRIMARY EXAMINER